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|--|---|------------------------|-----------------------|
| | | Application Number | 09/773,139 |
| | | Filing Date | January 31, 2001 |
| | | First Named Inventor | Otero, Hernan G. |
| | | Art Unit | 3628 |
| | | Examiner Name | Borlinghaus, Jason M. |
| Total Number of Pages in This Submission | 4 | Attorney Docket Number | G08.050 |

ENCLOSURES (Check all that apply)

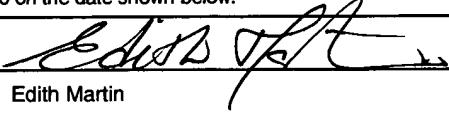
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| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|---|----------|--------|
| Firm Name | Buckley, Maschoff & Talwalkar LLC | | |
| Signature |  | | |
| Printed name | Nathaniel Levin | | |
| Date | August 11, 2006 | Reg. No. | 34,860 |

CERTIFICATE OF TRANSMISSION/MAILING

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| Signature |  | | |
| Typed or printed name | Edith Martin | Date | August 11, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: OTERO et al.

Application Serial No.: 09/773,139

Filing Date: January 31, 2001

For: APPARATUS, METHODS AND
ARTICLES OF MANUFACTURE
FOR CONSTRUCTING AND
EXECUTING TRANSACTION
PROCESSES AND PROGRAMS

Group Art Unit: 3628
Examiner: Jason M. Borlinghaus
REPLY TO EXAMINER'S ANSWER
Attorney Docket No.: G08.050
PTO Customer Number 28062
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date noted below:

Dated: August 11, 2006 By: Edith Martin
Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed on June 13, 2006, the following remarks are respectfully submitted.

Regarding claims 8, 9 and 19-23

Appellants will generally stand on the arguments contained in their Appeal Brief, except to debunk the Examiner’s proposal that the specific quantity of shares defined in a particular order may constitute a “limit on trading volume applicable in a ... market”.

In considering the well known “Immediate or Cancel” (IOC) order to be relevant to the claimed “limit on trading volume” the Examiner ignores the wording of the claim which specifies that the limit on trading volume is “applicable in a ... market”. Thus the limit on trading volume is an attribute of a market, not an attribute of a particular order, and would be clearly understood by those who are skilled in the art as applying to an aggregate of trades which occur in the market during a particular period of time. In view of the well established meaning of trading volume as an attribute of a market, and the claim language that invokes this meaning, it is not reasonable to interpret the phrase “limit on trading volume applicable in a ... market” as encompassing the quantity of shares specified for a particular order, since the quantity of shares in that case is the attribute of an order, not of a market in which an order is placed. It follows that the practice of IOC orders is not relevant to the claim limitation of plural market plug-ins each implementing a limit on trading volume applicable to a respective market. Thus the Examiner’s analysis fails at the point of novelty, and the Examiner has failed to make a prima facie case of obviousness with respect to claim 8 and the claims which it represents. Appellants submit that reversal of the pending rejection of these claims is in order.

Regarding claims 28-39

Appellants will again stand on the arguments made in their Appeal Brief, except to note that the Examiner has not in any way rebutted or addressed in his Answer the appellants’ point that the compliance module described in the “Handbook” appears to implement rules governing operation of a securities firm, and not “rules for a ... market”, as recited in claim 28. As such, the compliance module does not satisfy the claimed “market plug-ins for implementing rules for a respective market”.

Regarding claims 29 and 36

In failing to specifically address these claims in his Answer, the Examiner overlooks differences in wording in the claims, and the differences in the combinations of references respectively applied to claim 8 and to claim 29. In particular, the Examiner proposes in regard to claim 29 a combination of the IOC order practice with the compliance module described in the “Handbook”. This ignores the Examiner’s (erroneous) contention that the compliance module

implements market rules, and that the transaction-oriented IOC practice is irrelevant to limits on trading volume implemented as a part of market rules.

It is therefore respectfully submitted that the Examiner has failed to rebut appellants' argument that "in claim 29 the trading volume limit is implemented as part of a market rule, and not for a particular transaction as in an IOC order". Allowance of claims 29 and 36 is in order even if the other claims herein are not deemed to be patentable.

* * * * *

As required, this Reply is submitted within two months after the mailing of the Examiner's Answer.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,



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August 11, 2006
Date